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Ginger M. Graff 08/21/02
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	R. Rajagopalan et al.
Application No.:	09/898,809
Filed:	July 3, 2001
Title:	**Dye-Sulfenates for Dual Phototherapy**
Art Unit:	1624
Examiner:	Thomas C. McKenzie, Ph.D.
Atty. Docket No.:	MRD-63

Cincinnati, OH 45202 August 21, 2002

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the Office Action mailed July 25, 2002 in the above-referenced application, applicants elect with traverse Group 1 (claims 2 and 14), drawn to cyanine dye containing molecules.

However, applicants respectfully assert that such a restriction is improper. At the outset, applicants note that all the claims are directed to the structure designated by the formula in claim 1. More specifically, claims 1-11 recite a compound, and claims 12-30 recite a method of performing a procedure by administering the

compound designated by the formula of claim 1. Applicants now provide the following analysis in support of their assertion.

First, the Examiner's restriction forces applicants to fragment the invention they claimed within a single claim. Under *In re Weber, Soder, & Boksay*, 198 U.S.P.Q. 328, 331-32 (C.C.P.A. 1978) (copy attached) this is not permitted.

The invention in *Weber* related to cyclic diamine derivatives possessing a common psychotherapeutic property and was identified by a single generic formula expressed in Markush format. The instant invention relates to dye-sulfenates possessing a common physiological property and the derivatives are identified by a single generic formula (as in claim 1) expressed in Markush format.

In *Weber,* the court viewed the Examiner's restriction as tantamount to a refusal to examine. It held that the United States Patent and Trademark Office authority to restrict between claims of an application reciting one or more independent and distinct inventions, but does not have the authority to require an applicant to divide up a single claim and present it in different applications; this would allow an Examiner, rather than an applicant, to define an invention in violation of 35 U.S.C. §121, ¶2 ("The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention", emphasis added). Weber at 332. While recognizing the need for efficiency in limiting each application to one invention, the court stated that

> ...in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights [of the applicant] are paramount.

Second, §803.02 of the MPEP states that if the claims have unity of invention, it is improper to refuse to examine "that which applicants regard as their invention". Unity of invention exists where compounds included within a Markush group share a common utility and share a substantial structural feature as being essential to that utility.

With regard to the instant application, all the claimed compounds share a single structure including dye as shown in the formula of claim 1, and have the same utility as sulfenate derivatives and their bioconjugates for phototherapy of tumors and other lesions. Further, Applicants submit that apart from the dye, the structure disclosed by the formula of claim 1 of the instant application is novel.

For the reasons discussed, Applicants respectfully request that the Examiner reconsider the restriction requirement.

Applicants know of no fee due with this submission. However, if any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS. L.L.P.

David E. Jefferies
Reg. No. 46,800

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
(513) 241-2324 - Office
(513) 421-7269 - Facsimile
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